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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/925,372 09/08/97 DORNE-

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EXAMINER

12M2/1119

KURT G. BRISCOE
SPRUNG KRAMER SCHAEFER & BRISCOE
660 WHITE PLAINS ROAD
TARRYTOWN NY 10591-5144

ROBINSON, A

ART UNIT

PAPER NUMBER

1209

DATE MAILED: 11/19/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 2-5 and 10-14 is/are pending in the application.
- Of the above, claim(s) 13 and 14 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-5 and 10-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☒ received in Application No. (Series Code/Serial Number) 08/440,428
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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The amendment filed September 8, 1997 has been received.

The status of SN: 08/440,428, filed May 12, 1995, should be indicated in the specification.

As. per a restriction requirement set forth in paper number 6 of parent application S. N. 08/440,428, Applicants elected the invention of Group I, claims 2-5 and 10-12 and the specific compound imidoclopid. The restriction requirement as set forth in said paper number 6, and the election made in response to said requirement is adhered to.

Claims 13 and 14 are withdrawn from further consideration as being drawn to a non-elected invention.

Claims 2-5 and 10-12 are acted upon on their merits to the extent that they read on the elected invention.

Claims 3 and 4 are improperly dependent upon more than one claim. Correction is requested.

The term "non-systemically" (claim 10, line 2) should be changed to "topically" to put said claim in better form.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

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commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Claims 2-5 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kristiansen et al.(A), Shiokawa et al.(B), Elbert et al. (AT) and Derwent Abstract of JP 03,279,389 (AR”), all of record.

The prior art teaches that the claim designated pyridinylmethyl-imidazolidinium compounds, analogues, and isomers thereof are known insecticides, effective against insects of the type claimed. The Elbert et al. Reference, page 22; the Shiokawa et al. Reference, col 4, lines 62-67; and the Kristiansen et al. Reference, col. 4, lines 10-23 further teach that the claimed compounds, isomers and analogues thereof are non-toxic to animals, fish, birds, etc. Therefore, one skilled in this art would find ample motivation from the prior art supra to use the claimed compounds as insecticides applied to humans or animals to combat the target insects of the instant application with a reasonable expectation that said compounds would be safe and effective. Thus, no patentable distinction can be seen between the claims of record and the state of the art as taught by the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Robinson whose telephone number is (703) 308-4524.

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AJR

November 17, 1997

ALLEN J. ROBINSON
GRNIP EXAMINER
GRNIP1200